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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,836	11/06/2001	Kiyoshi Tateishi	041465-5126	4513

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT PAPER NUMBER

2655

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/985,836

Applicant(s)

TATEISHI, KIYOSHI

Examiner

Jorge L Ortiz-Criado

Art Unit

2655

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-26.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: In regard to item 3(a)
Regarding claims 1-17, The proposed amendments to the claims alters the scope of the invention previously examined and searched. Such amendments more cursory review of the prior art of record and/or inherently requires a New search. This is not performed at this time juncture under present USPTO practice. .

Continuation of 11. does NOT place the application in condition for allowance because: In regard to item 11

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that claims 22-23 and 25 the feature of "physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers" is CLEARLY described in Figures 1,4 and 5 and cited portions of the specifications page 18 lines 12-20, page 24 lines 8-13 and page 28 lines 1-21.

The examiner disagrees because cannot readily ascertain/map with the above claim language where in at least the cited portions above or the rest portions of the specification as originally filed such a disclosure/support is found, in the descriptive portion of the specification by reference to the drawings, designating the part or parts therein to which the TERM applies.

The above claim language fails to agree with such disclosure and contains subject matter, which was not described in the specification. Alternative, the claims can be construed as misdescriptive in that it fails to particularly point out and distinctly claim the disclosed invention. Applicant's cooperation is respectfully requested.

Furthermore, as for example in page 18 lines 12-20, recited below

"As shown in FIG. 1 .the physical addresses on the optical disk 100 are allocated in the order of the groove track 1A of the first recording layer 1, the groove track 2A of the second recording layer 2, the land track 1B of the first recording layer 1, the land track 2B of the second recording layer 2, the land track 3B of the third recording layer 3, the land track 4B of the fourth recording layer 4, the groove track 3A of the third recording layer 3, and the groove track 4A of the fourth recording layer 4"

In the above example portion NO description is found about the claim language "discontinuously". Not even any disclosure of "continuity relationship" is described with the claim language as used.

As far as the examiner can tell in each of the recording layers, for example the LAND TRACK 1B would be continuously to GROOVE TRACK 1A. (1A,1B,1C...etc)

However, even by considering and by interpreting the labels (1A,1B,2A,2B etc.) as to show the continuity"/discontinuously" claim language, the cited portion would show that the claims are construed as misdescriptive in that it fails to particularly point out and distinctly claim the disclosed invention, since would show the contrary.

Although, also the "continuity" would be subject matter, which was not described in the descriptive portion of the specification by reference to the drawings, designating the part or parts therein to which the TERM applies.

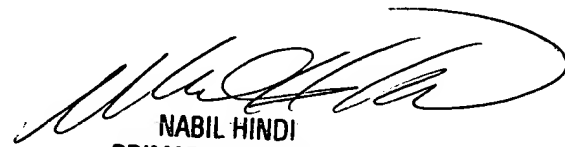
The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

So as to have CLEAR support or Antecedent basis in the specification, this is necessary in order to insure certainty in construing the claims in the light of the specification, Ex parte Kotler, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01.

Although, the claims are interpreted in light of the specification, limitations from the specification ARE NOT READ into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one with ordinary skill in the art at the time of the invention to form a double-spiral recording information in which information is recorded on both land tracks and groove tracks, in order to increase the recording capacity and further performing a continuous tracking operation at the time of recording/reproduction of the lands tracks and/or the grooves tracks, as suggested by Horimai et al. and further performing a continuous tracking operation at the time of recording/reproduction in the lands tracks and/or the grooves tracks, in each layer as taught by Ito et al. .


NABIL HINDI
PRIMARY EXAMINER
GROUP 2635